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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,913	08/09/2006	Leslie R. Wells	87253TJS	2930

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EASTMAN KODAK COMPANY  
PATENT LEGAL STAFF  
343 STATE STREET  
ROCHESTER, NY 14650-2201

EXAMINER
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RUST, ERIC A

ART UNIT	PAPER NUMBER
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4146

MAIL DATE	DELIVERY MODE
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08/03/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,913	<b>Applicant(s)</b> WELLS ET AL.	
	<b>Examiner</b> ERIC A. RUST	<b>Art Unit</b> 4146	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/09/2006</u> .  | 6) <input type="checkbox"/> Other: _____.                         |

### **DETAILED ACTION**

1. In the preliminary amendment filed August 09, 2006, claims 3 and 5 were amended. Currently, claims 1-6 are pending in this application.

### ***Priority***

2. Acknowledgment is made of Applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy of Application No. 0408349.9, filed on April 15, 2004, in the Great Britain Patent Office, has been received by the Office.

### ***Information Disclosure Statement***

3. Document No. 1,522,884 filed in Germany with a date of October 16, 1969, listed in the information disclosure statement filed August 09, 2006, fails to comply with 37 CFR 1.98(a)(3), which requires a concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language, and a copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c). The IDS has been placed in the application file, but the information referred to therein (specifically, document No. 1,522,884 filed in Germany with a date of October 16, 1969) has not been considered.

4. The Examiner notes that claim 6 recites "means" which perform certain functions. The specification, however, has no recited structure to correspond to the means in claim 6. As such, claim 6 will not be treated under 112 6<sup>th</sup>.

### ***Claim Objections***

5. Claim 5 is objected to because of the following informalities:
- **In regard to claim 5**, the preamble should recite "a method as claimed in claim 1," or some variation thereof. Moreover, the recitation "the variation in average print density," recited in line 3 of claim 5, lacks antecedent basis.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**In regard to claims 3 and 4**, the recitation "the volume of solution used for printing in each process step is less than 100ml", recited in line 2 of claim 3, is not

clearly understood. More specifically, it is not clear what each process step is. This renders the claim indefinite.

For purposes of examination, the Examiner will interpret this recitation as meaning the volume of solution (i.e., ink) used to print one image is less than 100ml.

Claim 4 is rejected for depending on claim 3, and not solving the problems of claim 3.

**In regard to claim 5**, the recitation “whereby the variation in average print density is reduced from one print to another,” recited in lines 3-4 of claim 5, is not clearly understood. More specifically, according to Applicants’ description, the variation in average print density would be static when printing two images (i.e., one print to another), and would only change as the print sequence continues. Accordingly, this renders the claim indefinite.

For purposes of examination, the Examiner will interpret this recitation as meaning that as the images are printed, the variation in average print density is reduced. For example, the first two images printed would have the largest variation in density, the next two images printed would have a lower variation in density, and the final two images printed would have the lowest variation in density.

#### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,381,033 B1 to Morba et al. (hereinafter, Morba).

**In regard to claim 1**, Morba discloses a method of printing an image onto photographic material (**Morba, col. 2, lines 15-17**) comprising:

obtaining digital density information of a print order comprising a number of images (**Morba, col. 2, lines 15-17, in order to print an image from a scanner, a signal corresponding to a digital density needs to be obtained so that the image can be reproduced, this would include the digital density information of a print order**),

determining an optimum sequence of printing the images in the order (**Morba, col. 5, line 66 – col. 6, line 5**), and

printing the images in the optimum sequence (**Morba, col. 5, line 66 – col. 6, line 5**).

**In regard to claim 6**, Morba discloses an apparatus (**Morba, Fig. 1**) for printing images onto photographic media (**Morba, col. 2, lines 15-17**) comprising:

means for obtaining digital density of a print order comprising a number of images (**Morba, col. 2, lines 15-17, in order to print an image from a scanner, a**

**signal corresponding to a digital density needs to be obtained so that the image can be reproduced, the means is Fig. 1, item 12),**

means for determining an optimum sequence of printing the images in the order (Morba, col. 5, line 66 – col. 6, line 5, the means would be the user using the machine of Fig. 1, or Fig. 1, item 45) and

means for printing the images in the optimum order (Morba, col. 5, line 66 – col. 6, line 5, the means is Fig. 1, item 45).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being obvious in view of Morba.

**In regard to claim 2**, Morba does not specifically disclose wherein the images are printed in the sequence of the image having the highest density followed by the image having the least density, followed by the image having the next highest density, followed by the image having the next least density, the sequence being followed until all images are printed.

Morba, however, does disclose that any desired predetermined criteria may be used for determining a printing sequence to meet, for example, the needs of the printer (**Morba, col. 5, line 66 – col. 6, line 5**).

Moreover, the limitations in claim 2 are nothing more than a sequence of printing for optimal printing. The Examiner notes that there is only a finite number of sequences to print a sequence of images.

Accordingly, it would have been obvious for a person of ordinary skill in the art at the time if the invention to try the finite number of limitations, and this would lead to the above limitations. See MPEP 2143.

**In regard to claim 3**, Morba does not specifically disclose wherein the volume of solution used for printing in each process step is less than 100ml.

Applicant, however, has not disclosed any specific advantage or criticality of having the volume of solution used for printing in each process step being less than 100ml. As such, the above limitation is a matter of design choice.

Accordingly, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to have the volume of solution used for printing in each process step be less than 100ml in order to reduce and regulate the flow of the solution.

**In regard to claim 4**, Morba does not specifically disclose wherein the volume of solution is less than 30ml.



Applicant, however, has not disclosed any specific advantage or criticality of having the volume of solution being less than 30ml. As such, the above limitation is a matter of design choice.

Accordingly, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to have the volume of solution be less than 30ml in order to reduce and regulate the flow of the solution.

**In regard to claim 5**, Morba does not specifically disclose whereby the variation in average print density is reduced from one print to another.

Morba, however, does disclose that any desired predetermined criteria may be used for determining a printing sequence to meet, for example, the needs of the printer **(Morba, col. 5, line 66 – col. 6, line 5)**.

The Examiner notes that there are only a finite number of sequences to print a sequence of images. One sequence, for example, a sequence of the image having the highest density printed followed by the image having the least density printed, followed by the image having the next highest density printed, followed by the image having the next least density printed, would result in the variation in average print density being reduced from one print to another.

Accordingly, it would have been obvious for a person of ordinary skill in the art at the time if the invention to try the finite number of limitations, and this would lead to the above limitations. See MPEP 2143.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC A. RUST whose telephone number is (571)-270-3380. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on (571)-272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. A. R./  
Examiner, Art Unit 4147  
07/27/2009

/ANAND BHATNAGAR/  
Primary Examiner, Art Unit 2624  
July 30, 2009